

Remarks

This Response is in reply to the Final Office Action dated **May 28, 2008**, wherein the Office rejected claims 38 – 40, 42, and 44 – 45 under 35 U.S.C. § 102.

The following comments are presented in the same order and with headings corresponding to the rejections set forth in the Office Action.

Claim Rejections—35 U.S.C. § 102

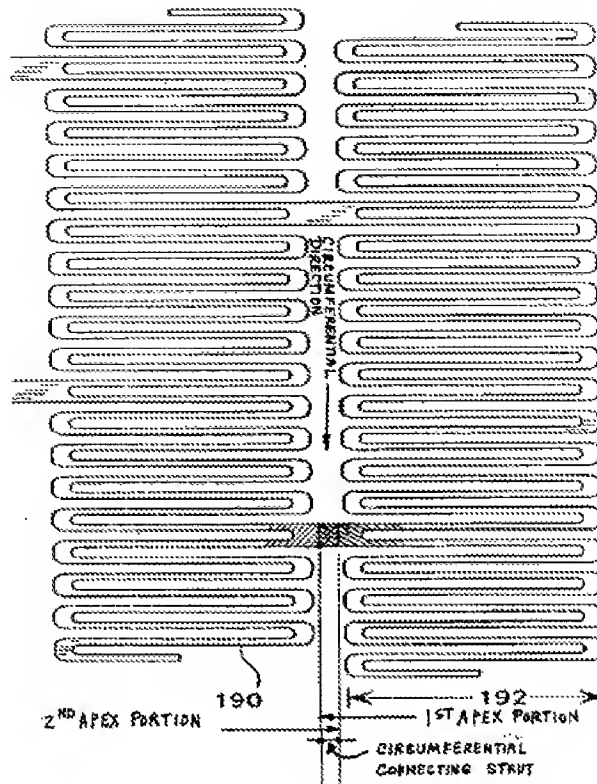
The Office rejected claims 38 – 40, 42, and 44 – 45 under 35 U.S.C. § 102(e), alleging the same to be anticipated by U.S. Patent No. 5,873,906 to Lau et al. (hereafter “Lau”).

The Office rejected claims 38 – 40 and 44 – 45 under 35 U.S.C. § 102(e), alleging the same to be anticipated by U.S. Patent No. 6,132,460 to Thompson (hereafter “Thompson”).

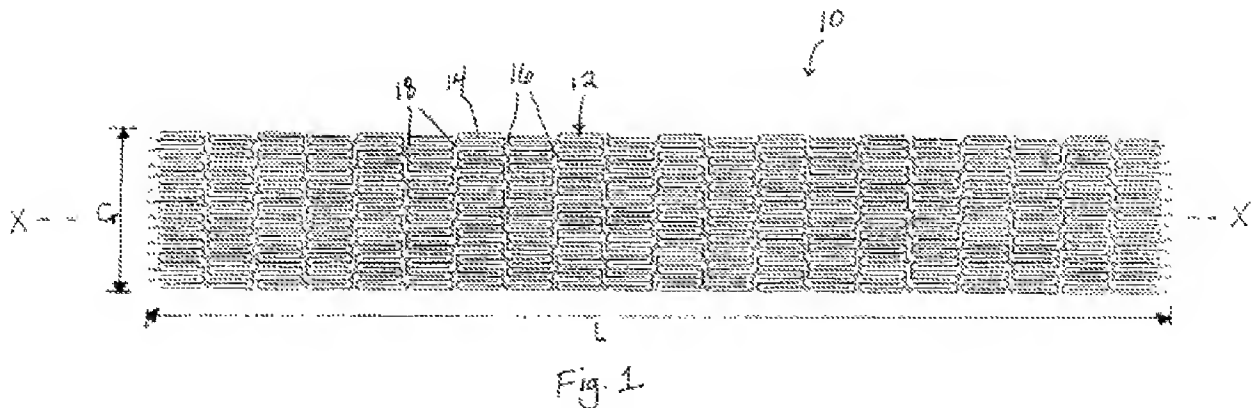
The Lau Reference

Lau fails to teach or suggest all the elements of claim 38. Claim 38 was copied from U.S. Patent Application Publication No. 2003/0055485 to Lee et al. (hereafter “Lee”) in order to provoke an interference. Because the Applicants have copied claim 38 from Lee in order to provoke an interference, and because Lee describes the claim terms, the Office must adopt the definitions, meanings, and/or usages of the terms in claim 38 *as those terms are used in the Lee*, as will be described below.

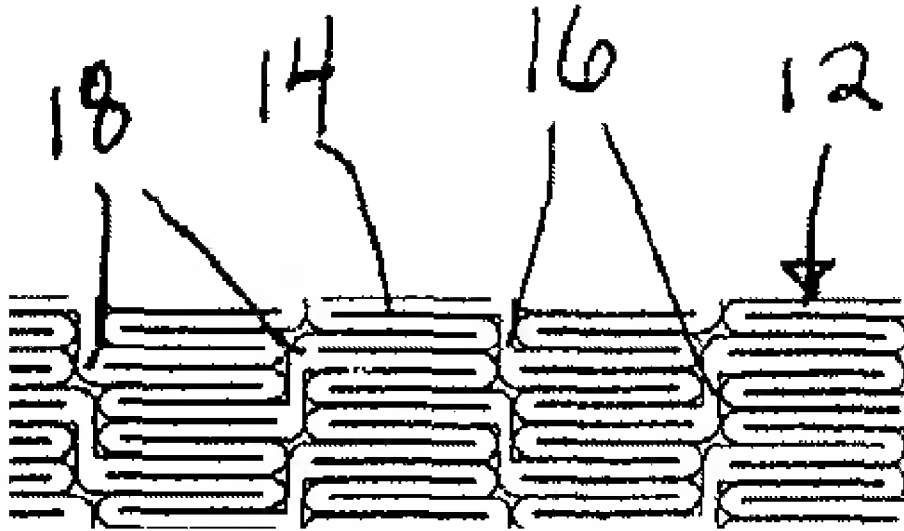
The Office attempted to equate the limitations of claim 38 with FIG. 13 of Lau, as shown below in the *annotated* version of FIG. 13 included in the Office Action:



However, the annotated labels added by the Office are at odds with the written description and the figures of Lee, from which claim 38 was copied. FIG. 1 of Lee is presented immediately below:



Shown below is an enlarged portion of FIG. 1 of Lee:



Lee states, “Adjacent support structures 12 are joined by circumferential connecting struts 16 joining apex portions 18. The phrase "circumferential connecting struts" or "circumferential connecting members" will be understood to mean struts or members that interconnect adjacent circumferential support structures 12 and have a spacial component or vector that extends in a circumferential direction about the stent 12.” (Paragraph [0022]).

Lee further states, “When the stent 10 [of FIG. 1] is in the deployed orientation, as shown in FIG. 2, the apex portions 18 on adjacent support structures 12 are offset.” (Emphasis added)(Paragraph [0032]). And, “[i]n one embodiment, as shown in FIG. 2, the distance of offset D_1 provided by the connection member 16 is about one-half the distance D_2 provided between the apex portions 18...” (Emphasis added)(Paragraph [0033]). In other words, it is the “spacial component or vector that extends in a circumferential direction about the stent 12” that allows the apex portions 18 to be offset when the stent is in a deployed orientation. (Paragraph [0022]).

Upon comparing *annotated* FIG. 13 of Lau with FIG. 1 of Lee, it is clear the Office has taken a distinct, and unsupported, interpretation of the claim terms in claim 38. In the Office Action, the Office states that, “there is no specific limitation defining various elements as recited in the claims, such as longitudinal strut (claim 38) or apex portion (claim 38) or a circumferential connecting strut (claim 38) in the claims. Therefore, it would be reasonable to interpret these claims in various ways that meet the limitations of the claims.” Applicants

respectfully assert that this is incorrect.

The Office's interpretation is incorrect because "[w]hen interpretation is required of a claim that is copied for interference purposes, the copied claim is viewed in the context of the patent from which it was copied." *In re Spina*, 975 F.2d 854, 858, 24 USPQ2d 1142, 1145 (Fed. Cir. 1992), citing *DeGeorge v. Bernier*, 768 F.2d 1318, 1322, 226 USPQ 758, 761 (Fed.Cir. 1985) (if claim language is ambiguous "resort must be had to the specification of the patent from which the copied claim came"). "A claim is not interpreted one way in light of the specification in which it originally was granted, and another way in light of the specification into which it is copied as a proposed interference count." *In re Spina*, 24 USPQ2d at 1145.

Furthermore, "USPTO personnel are to correlate each claim limitation to all portions of the disclosure that describe the claim limitation. This is to be done in all cases, regardless of whether the claimed invention is defined using means or step plus function language. The correlation step will ensure that USPTO personnel correctly interpret each claim limitation." MPEP § 2106. And, "USPTO personnel must always remember to use the perspective of one of ordinary skill in the art. Claims and disclosures are not to be evaluated in a vacuum. If elements of an invention are well known in the art, the applicant does not have to provide a disclosure that describes those elements." *Id.*

Therefore, because the Applicants have copied claim 38 from Lee in order to provoke an interference, and because Lee describes the claim terms, the Office must adopt the definitions, meanings, and/or usages of the terms in claim 38 *as those terms are used in the Lee*.

It is clear that the "circumferential connecting struts", as labeled by the Office in the annotated FIG. 13 of Lau supplied in the Office Action, do not "extend[] in a circumferential direction about the stent 12," as one of ordinary skill in the art would construe the phrase "circumferential connecting struts" to mean in light of the Lee specification. And, it is clear that under the claim interpretation proposed by the Office, the apex portions joined by the "circumferential connecting struts", as labeled by the Office in the annotated FIG. 13 of Lau supplied in the Office Action, would not be offset once the stent is deployed, as in Lee. Therefore, the interpretation supplied by the Office is incorrect because it would defeat the purpose of the circumferential connecting struts—creating offsets—expressly stated in the Lee specification. To that end, Lau is not anticipatory.

Claims 39 – 40, 42, and 44 – 45 incorporate all the limitations of claim 38 and add additional limitations, making them patentable as well over Lau. Applicants traverse the rejections of claims 38 – 40, 42, and 44 – 45 and request that the rejection be withdrawn.

The Thompson Reference

Thompson fails to teach or suggest all the elements of claim 38. Claim 38 was copied from U.S. Patent Application Publication No. 2003/0055485 to Lee et al. (hereafter “Lee”) in order to provoke an interference. As discussed above, because the Applicants have copied claim 38 from Lee in order to provoke an interference, and because Lee describes the claim terms, the Office must adopt the definitions, meanings, and/or usages of the terms in claim 38 *as those terms are used in the Lee*.

The Office attempted to equate the limitations of claim 38 with FIG. 7 of Thompson, as shown below in the *annotated* version of FIG. 7 included in the Office Action:

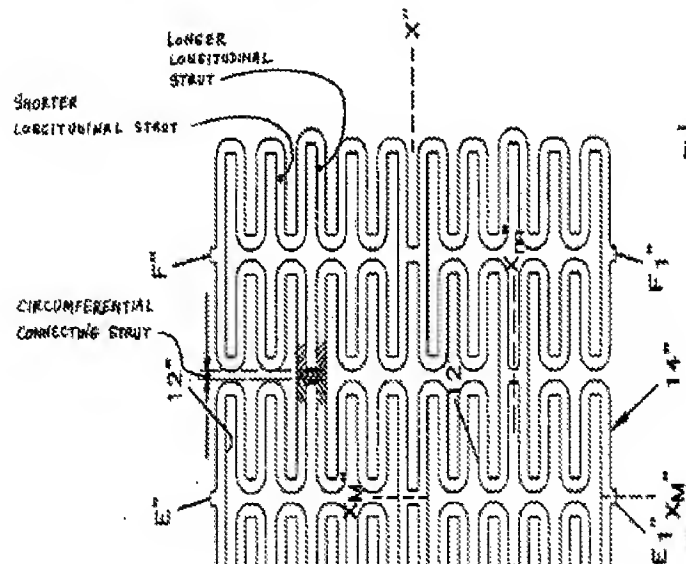


FIG. 7

It is clear that the “circumferential connecting struts”, as labeled by the Office in the annotated FIG. 7 of Thompson supplied in the Office Action, do not “extend[] in a circumferential direction about the stent 12,” as one of ordinary skill in the art would construe the phrase “circumferential connecting struts” to mean in light of the Lee specification. And, it is clear that under the claim interpretation proposed by the Office, the apex portions joined by the

“circumferential connecting struts”, as labeled by the Office in the annotated FIG. 7 of Thompson supplied in the Office Action, would not be offset once the stent is deployed, as in Lee.

Therefore, the interpretation supplied by the Office is incorrect because it would defeat the purpose of the circumferential connecting struts—creating offsets—expressly stated in the Lee specification. To that end, Thompson is not anticipatory.

Claims 39 – 40 and 44 – 45 incorporate all the limitations of claim 38 and add additional limitations, making them patentable as well over Thompson. Applicants traverse the rejections of claims 38 – 40 and 44 – 45 and request that the rejection be withdrawn.

Conclusion

In light of the arguments presented above, Applicants submit that the instant application, with pending claims 38 – 45, is in condition for allowance. Favorable consideration and early action to that effect are solicited earnestly.

Should the Examiner have any questions regarding this Response, the Examiner is invited to contact the Applicants’ undersigned representative at the telephone number presented below.

Respectfully submitted,

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